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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/729,866
Filing Date: December 06, 2000
Appellant(s): YAMANAKA ET AL.

Gregory J. Maier (Reg. No. 25,599)
Surinder Sachar (Reg. No. 34,423)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/05/2008 appealing from the Office action mailed 03/18/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments

The appellant's statement of the status of amendments contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0073451	Maari	04-2004
PCT/JP00/01903	Nagano	05-2002
5,740,549	Reilly et al.	04-1998
2001/0041053	Abecassis	11-2001
5,958,061	Merriman et al.	09-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

In view of the Appeal Brief filed on September 15, 2006, PROSECUTION IS
HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth
in 37 CFR 41.20 have been increased since they were previously paid, then appellant
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691

Priority

Acknowledgment is made of applicant's claim for priority to Japanese application JAPAN 2000-20770 01/28/2000.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 5-8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maari, U.S. Pub No. 2004/0073451 (reference A in attached PTO-892) in view of Nagano, International Application No. PCT/JP00/01903 (reference N in attached PTO-892).

3. As per claims 2 and 19, Maari teaches a digital content billing system using a network (see Fig. 1), comprising:

a holder having digital content, which is set to become usable by an execution key, and holding a right to let a user use the digital content (see Fig. 1, Content Provider (240); see paragraph [0071]; where content provider carries copyright holder and determine fees to be billed to user for digital content);

a distributor obtaining the digital content from the holder and distributing to the digital content to a user (Fig. 5, Administrative Center (211); paragraph [0072]); where Administrator Center acts as distributor of digital contents, receives digital content from content provider or holder);

an administrator server obtaining the execution key from the holder (see Fig. 5; paragraph [0071]; where administrator center encodes and compresses the digital content with content ID provided by content provider);

receiving execution declaration of the digital content from the user (see Fig. 5; paragraph [0068]; where user request desired digital content which includes video (movie, advertisement and audio data);

downloading advertising information piece and the execution key to the user through the network (see Fig. 5, paragraph [0072], [0078] and [0082]); and

paying an execution fee to the holder (see Fig. 7, step 4; paragraph [0063] and [0071]; where fee is paid to digital content provider).

Maari does not teach an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser; and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user.

Nagano teaches an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser (Nagano, Fig. 1, Advertising Data Input Device (10) and Advertising Data Database (14) Paragraph [0019], [023] and [0024]); and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user (see Fig. 1, Advertising-Fee Calculation/Notification Device (20); Fig. 3, steps S12; paragraph [0026]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include an advertiser possessing an advertising information piece to be provided for the user; obtain the advertising information piece from the advertiser; and collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user of Maari because Nagano teaches that incorporating above features would enable to determine whether a user actually accessed supplied advertising data accommodating advertisement sponsors (or advertiser) who wish to provide advertising data under a limited budget (Nagano, paragraph [0007]).

4. As per claim 5, Maari in view of Nagano teach claim 2 as described above.

Maari further teaches the digital content billing system using a network wherein,

the holder (administrator center) pays to the distributor server a download charge ((see Fig. 7, step 4; paragraph [0063] and [0071]; where fee is paid to digital content provider).

Maari does not teach the distributor server notifies the holder of the number of download times of the digital content downloaded to the user.

Nagano teaches notifying the number of times digital content has been clicked or downloaded (see Fig. 1, Advertising-Fee Calculation/Notification Device (20); Fig. 3, steps S12; paragraph [0026]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include notifying the number of times digital content has been clicked or downloaded of Maari because Nagano teaches that incorporating above features would enable calculate fee for use of digital content by verifying whether a user actually accessed supplied data accommodating sponsors (or advertiser) who wish to provide advertising data under a limited budget (Nagano, paragraph [0007]).

5. As per claim 6, Maari in view of Nagano teach claim 2 as described above. Maari further teaches the digital content billing system using a network wherein,

when the administrator server receives the execution declaration from the user, the administrator server downloads to the user a plurality of advertising information pieces and the execution key, which permits the user to use the digital content a prescribed number of times (see Fig. 5, paragraph [0060] and [0071]; where administrator center supplies the digital content requested by the user).

6. As per claim 7-8, Maari in view of Nagano teach claim 2 as described above. Maari further teaches the digital content billing system using a network wherein when the execution key is not currently downloaded to the user from the administrator server because of an abnormal state even though a prescribed time has passed after

the user sent the execution declaration of the digital content, the user uses the digital content by using an execution key downloaded from the administrator server in the past while seeing an advertising information piece downloaded from the administrator server in the past; and after the abnormal state has passed the user notifies the administrator server that the user used the digital content by using the execution key downloaded from the administrator server in the past (see paragraph [0057], [0082] and [0096]; where transfer data from administration center based on either common-key encryption or public-key encryption and arrangement can be made by administrative center for using previous execution due to an abnormal state).

7. Claims 3-4, 9-11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maari, U.S. Pub No. 2004/0073451 (reference A in attached PTO-892) in view of Nagano, International Application No. PCT/JP00/01903 (reference N in attached PTO-892) further in view of Reilly et al. U.S. Patent No. 5,740,549 (reference B in attached PTO-892).

8. As per claim 3-4, and 9, Maari in view of Nagano teach claim 2 as described above. Maari further teaches user using the digital content by using the execution key downloaded to the user by administrative center (see Fig. 2; paragraph [0071] and [0082]).

Maari does not teach the advertising information piece downloaded to the user is displayed simultaneously and in between time periods with the digital content and the

advertising information piece downloaded from the administrator server to the user corresponds to content of the digital content.

Reilly et al. teach the advertising information piece downloaded to the user is displayed simultaneously and in between time periods with the digital content and the advertising information piece downloaded from the administrator server to the user corresponds to content of the digital content (see Fig. 6 and 10; column 1, lines 57-58; column 2, lines 28-34, 42-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the advertising information piece downloaded to the user is displayed simultaneously and in between time periods with the digital content the advertising information piece downloaded from the administrator server to the user corresponds to content of the digital content of Maari in view of Nagano because Reilly et al. teach that incorporating above features would enable to provide a "targeted" audience for the advertisers (Reilly et al., column 2, lines 43-47).

9. As per claims 10-11 and 14-16, Maari in view of Nagano teach claim 2 as described above. Maari further teaches the digital content billing system using a network wherein

the administrator server receives the execution declaration of the digital content from the user (see Fig. 5; paragraph [0068]; where user request desired digital content which includes video (movie, advertisement and audio data)) and administrator center supplying digital content (including advertisement) to the user (see Fig. 5; paragraph [0071]).

Maari does not teach the administrator server requiring the user to select a residential district of the user and a genre of the advertising information piece to be downloaded to the user, and the advertising information piece of the selected genre is downloaded to the user; the administrator server downloads to the user the advertising information piece that corresponds to content of another digital content used by the user in the past; the digital content that closely relates to the residential district of the user and a nationwide digital content to the user, which is obtained from a network operator managing the network.

Reilly et al. teach profiler for storing user viewing preferences indicating information categories for which the user does or does not want to information items (Reilly et al., abstract; Fig. 3 and 4; column 7, lines 13-27) and displaying advertisement associated with same category of digital content displayed (Reilly et al., column 2, lines 42-47).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include profiler for storing user viewing preferences indicating information categories for which the user does or does not want to information items to be displayed and displaying advertisement associated with same category of digital content displayed of Maari in view of Nagano because Reilly et al. teach that incorporating above features would enable to fulfill user's interest in receiving information relating to particular categories and provide a "targeted" audience for the advertisers (Reilly et al., column 2, lines 43-47; column 7, lines 13-20).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maari, U.S. Pub No. 2004/0073451 (reference A in attached PTO-892) in view of Nagano, International Application No. PCT/JP00/01903 (reference N in attached PTO-892) further in view of Abecassis, U.S. Pub No. 2001/0041053 (reference C in attached PTO-892).

11. As per claim 12, Maari in view of Nagano teach claim 2 as described above.

Maari does not teach the administrator server collects the advertisement rate from the advertiser that is determined according to a matching point between content of the digital content related to the execution declaration of the user and content of the advertising information piece downloaded from the administrator server to the user.

Abecassis teaches compensating viewers of advertisement and compensation rate is based on specific advertisement presented in a manner consistent with the viewer's taste level for a product and services for which viewer has an interest (Abecassis, paragraph [0035]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include advertisement rate from the advertiser that is determined according to a matching point between content of the digital content related to the execution declaration of the user and content of the advertising information piece downloaded from the administrator server of Maari in view of Nagano because Abecassis teaches that incorporating above features would enable to subsidize cost to viewers by matching viewers interest in the subject of the commercials to potential purchase by the viewer of that product and services (Abecassis, paragraph [0036]).

12. As per claim 17, Maari teaches a digital content billing system using a network, comprising:

an administrator server obtaining the execution key from the holder(see Fig. 5; paragraph [0071]; where administrator center encodes and compresses the digital content with content ID provided by content provider), receiving an execution declaration of the digital content from the user (see Fig. 5; paragraph [0068]; where user request desired digital content which includes video (movie, advertisement and audio data), downloading the execution key to the user through the network (see Fig. 2; paragraph [0071] and [0082]);

a distributor server obtaining from the holder the digital content that includes the advertising information piece and distributing the digital content with the advertising information piece to the user (Fig. 5, Administrative Center (211); paragraph [0072]); where Administrator Center acts as distributor of digital contents (includes advertising), receives digital content from content provider or holder).

Maari does not teach an advertiser possessing an advertising information piece to be provided for a user; a holder receiving the advertising information piece from the advertiser, and notifying the advertiser of the number of execution times of the digital content used by the user, wherein the holder collects an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user.

Nagano teaches an advertiser possessing an advertising information piece to be provided for a user; a holder receiving the advertising information piece from the advertiser (Nagano, Fig. 1, Advertising Data Input Device (10) and Advertising Data Database (14) Paragraph [0019], [023] and [0024]), and notifying the advertiser of the number of execution times of the digital content used by the user, wherein the holder collects an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user (see Fig. 1, Advertising-Fee Calculation/Notification Device (20); Fig. 3, steps S12; paragraph [0026]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include an advertiser possessing an advertising information piece to be provided for a user; a holder receiving the advertising information piece from the advertiser, and notifying the advertiser of the number of execution times of the digital content used by the user, wherein the holder collects an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user of Maari because Nagano teaches that incorporating above features would enable to determine whether a user actually accessed supplied advertising data accommodating advertisement sponsors (or advertiser) who wish to provide advertising data under a limited budget (Nagano, paragraph [0007]).

Maari does not teach the holder paying a download charge to the administrator server that corresponds to the number of download times of the execution key downloaded from the administrator server to the user.

Abecassis teaches compensating for verified apparent viewing of advertisement independent of use of other services (Abecassis, Fig. 12B, paragraph [0036]; where user is credited viewing the advertisement; Examiner interprets the compensation provided to administrator in turn transmitted to the viewer ultimately).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include compensating for verified apparent viewing of advertisement independent of use of other services of Maari because Abecassis teaches that incorporating above features would enable to increase the potential of purchasing product and services by the viewer (Abecassis, paragraph [0036]).

13. As per claim 18, Maari in view of Nagano further in view of Abecassis teach claim 17 as described above.

Maari does not teach the distributor server notifies the holder of the number of download times of the digital content downloaded to the user.

Nagano teaches the distributor server notifies the holder of the number of download times of the digital content downloaded to the user (see Fig. 1, Advertising-Fee Calculation/Notification Device (20); Fig. 3, steps S12; paragraph [0026]).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include the distributor server notifies the holder of the number of download times of the digital content downloaded to the user of Maari because Nagano teaches that incorporating above features would enable to calculate the cost and to determine whether a user actually accessed supplied advertising data accommodating

advertisement sponsors (or advertiser) who wish to provide advertising data under a limited budget (Nagano, paragraph [0007]).

Maari does not teach the holder pays a download charge to the distributor server that corresponds to the number of download times of the digital content.

Abecassis teaches compensating for verified apparent viewing of advertisement independent of use of other services (Abecassis, Fig. 12B, paragraph [0036]; where user is credited viewing the advertisement; Examiner interprets the compensation provided to distributor (administrator) in turn transmitted to the viewer ultimately).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include compensating for verified apparent viewing of advertisement independent of use of other services of Maari because Abecassis teaches that incorporating above features would enable to increase the potential of purchasing product and services by the viewer (Abecassis, paragraph [0036]).

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maari, U.S. Pub No. 2004/0073451 (reference A in attached PTO-892) in view of Nagano, International Application No. PCT/JP00/01903 (reference N in attached PTO-892) further in view of Merriman et al, U.S. Patent No. 5,948,061 (reference D in attached PTO-892).

15. As per claim 13, Maari in view of Nagano teach claim 2 as described above.

Maari does not teach the administrator server guaranteeing the advertiser a minimum number of downloading times the advertising information piece is downloaded

to the user or a minimum ratio of the number of downloading times the advertising information piece is downloaded to the user to the number of downloading times of all advertising information pieces downloaded to the user.

Merriman et al. teach guaranteeing the advertiser a minimum number of downloading times the advertising information piece is downloaded to the user (Merriman et al., Fig. 3B, Target No.; column 4, lines 61-62).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to include guaranteeing the advertiser a minimum number of downloading times the advertising information piece is downloaded to the user of Maari in view of Nagano because Merriman et al. teach that incorporating above features would enable to determine effectiveness of advertising and to guarantee to reach as many individuals in advertiser's target group as possible (Merriman et al., column 1, lines 23-27).

(10) Response to Argument

Claims 2, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maari, U.S. Pub No. 2004/0073451 in view of Nagano, International Application No. PCT/JP00/01903.

Followings are the list of arguments of the appellant against the combination of references used by the Examiner for rejection of above claims in the instant application:

1) None of the cited art discloses or suggests collecting "an advertising rate from the advertiser that corresponds to the number of execution times of the digital content

used by the user" (emphasis added), as positively recited in each of independent claims 2, 17, and 19.

2) None of the applied art discloses or suggests such a feature, and the outstanding rejection is misconstruing that feature relative to the applied art, particularly as the cited art to Nagano only discloses providing a payment based on a number of times that a user accesses an advertisement, and not digital content to which an advertisement is added.

3) In the claimed invention, the advertiser is not billed based on the number of times an advertisement is clicked on or executed, but instead is billed based on the number of times digital content to which advertisement is added is executed.

4) Nagano does not disclose or suggest collecting an advertising rate from an advertiser that corresponds to a number of execution times of digital content. Instead, Nagano discloses collecting an advertising rate from an advertiser corresponding to a number of times of clicking on an advertisement.

5) In the claimed invention, advertising is added to digital contents, but an advertising rate is calculated based on the number of times the digital content is executed. In the claimed invention an advertisement rate is not collected based on the number of times an advertisement is clicked on.

In response to appellant's arguments above, Nagano teaches advertising system and method for using electronic communication where the system uses electronic means to transmit articles in **digital form** from magazines and other and other publications to a customer (column 2, paragraph [0004]). Advertisement is, therefore, a

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digital content. Claims 2, 17 and 19 recites "collecting an advertisement rate from the advertiser that corresponds to the number of execution times of the digital content used by the user". Nagano further teaches the advertisement, a digital content, is displayed on the display device on each execution or click of mouse device by the user and advertisement fee is calculated accordingly (paragraph [0026]).

Examiner further notes that teaching of Nagano is applicable to digital content containing an advertisement piece where clicking or execution of digital content results display of the said advertisement piece. Nagano's teaching is based on charging for services that corresponds to number of execution times or clicks irrespective of whether it results in display of digital content, digital advertisement information or any other information.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted.

/Bijendra K. Shrestha/

Patent Examiner

Art Unit 3691

/Alexander Kalinowski/

Art Unit: 3691

Supervisory Patent Examiner,

Art Unit 3691

Conferees:

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